

Amendment and Response under 37 C.F.R. 1.116

Applicant: Robert Davidson

Serial No.: 09/760,242

Filed: January 12, 2001

Docket No.: 10002343-1

Title: PERSONAL MOVIE STORAGE MODULE

REMARKS

The following remarks are made in response to the Final Office Action mailed January 13, 2005. In that Office Action, the Examiner rejected claims 1, 4, and 5 under 35 U.S.C. §103(a) as being unpatentable over Cantone, U.S. Patent No. 5,734,781 ("Cantone") in view of Richie, U.S. Patent No. 4,809,089 ("Richie") and Jamie Beckett's article entitled "Making Room for Digital Data" ("Beckett"). Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett, as applied to claim 1, and further in view of Allen, U.S. Patent No. 5,909,638 ("Allen"). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett, as applied to claim 1 above, and further in view of Chung, U.S. Patent No. 6,628,963 ("Chung"). Claims 6 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett, as applied to claim 1 above, and further in view of Yamagata et al., U.S. Patent No. 4,908,793 ("Yamagata"). Claims 9, 10, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Richie, Beckett, and Yamagata. Claims 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, Beckett, and Yamagata, as applied to claim 9 above, and further in view of Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"). Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Richie, Beckett, Yamagata, and Allen. Claims 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett, as applied to claim 1 above, and further in view of Russo, U.S. Patent No. 5,619,247 ("Russo").

With this Response, claims 1-4, 6, 8, 9, 15, and 16 have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. §103

On pages 2-4 of the Office Action, the Examiner rejected claims 1, 4, and 5 under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Richie and Beckett. The following is a brief summary of the Examiner's remarks. The Examiner indicated that Cantone discloses a method of portable handling a movie including storing an electronically readable movie in a portable movie storage module, referencing column 2, lines 55-60. The

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Examiner also indicated that Cantone discloses connecting the portable storage module to a movie playback device, as well as recalling selectively the movie from the portable storage module into the movie playback device, referencing the VCR of Figure 3 and disclosed at column 2, lines 60-62. Further, the Examiner indicated that Cantone discloses displaying the movie, referencing column 2, lines 62-65.

The Examiner indicated that Cantone fails to specifically disclose wherein the playback device is portable, as well as displaying the movie on the playback device. The Examiner also indicated that Cantone fails to disclose wherein the storage module includes an atomic resolution storage memory.

The Examiner indicated that Richie discloses the use of a portable video playback device, referencing Figure 1 and column 2, lines 7-14, which will display video, referencing column 2, lines 20-28, from a storage module, referencing a videocassette at column 2, lines 37-43, for the benefit of allowing video playback at various locations, referencing column 1, lines 50-62. Additionally, the Examiner indicated that Beckett discloses an information storage device consisting of an atomic resolution storage component, referencing page 1, paragraphs 5 and 6.

With this Amendment, independent claim 1 has been amended to clarify the claimed invention. In particular, independent claim 1 has been amended such that the method of portably handling a movie includes storing a digital movie to a portable digital movie storage module and connecting the portable digital movie storage module to a portable digital movie playback device. The method further includes recalling selectively the digital movie from the memory component of the portable digital movie storage module into the portable digital movie playback device and displaying the digital movie on the portable digital movie playback device.

None of the cited references, either taken singularly or in combination, teach, suggest, or disclose storing a digital movie into a portable digital movie storage module or connecting the portable digital movie storage module to a portable digital movie playback device. In addition, none of the references teaches, suggests, or discloses recalling selectively the digital movie from the portable digital movie module into the portable digital movie playback device or displaying the digital movie on the portable digital movie playback device, since none of the cited references teach, suggest, or disclose a portable digital movie storage playback

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device capable of selectively recalling a digital movie and displaying the digital movie. In particular, Cantone discloses a videocassette for digitally storing compressed video and audio data; however, the digital data is converted to analog by means of a digital-to-analog converter within controller logic board 20 and transferred to the tape loop 16. If the data is stored in a compressed format, then it is decompressed before it is converted to analog (see Cantone, column 4, lines 19-24). Cantone further discloses that the converted analog data is then transferred and recorded onto the tape loop 16. During playback, the tape loop 16 continuously rotates and passes along the playback device's contact head 20, which reads the analog information. The recorded analog data is instantaneously erased from the tape loop 16 after it has been read by the playback head. The tape loop 16 then passes through the magnetic storage to tape contact head 14 where it is re-recorded with additional data (see Cantone, column 4, lines 25-34).

Cantone merely discloses transferring analog data from a VCR-sized cassette to a conventional VCR machine capable of reading the analog data. In addition, Cantone discloses displaying the analog data on an additional component – a television – rather than displaying the digital movie on the digital portable movie playback device, which recalled the digital movie from the memory component of the portable digital movie storage module. Cantone does not disclose recalling selectively a digital movie or disclose displaying a digital movie.

Richie discloses a portable videocassette player, which includes videocassette reel structure 26. Videocassette detector 52 of Richie includes pick-up heads 58 and 60 positioned adjacent videocassette reel 26 in the usual manner to pick-up the audio and video signals from the video tape in a videocassette within the videocassette reel structure 26 (see Richie, column 3, lines 41-48). Richie does not disclose recalling selectively a digital movie from a memory component of a portable digital movie storage module into a portable digital movie playback device and displaying the digital movie on the portable digital movie playback device as claimed in independent claim 1.

Beckett is cited for teaching the concept of atomic resolution storage (ARS). Beckett does not disclose digital movies, portable digital movie storage modules, or portable digital movie playback devices.

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It is Applicant's belief that independent claim 1, and depending claims 4 and 5, are patentably distinguishable over the prior art of record.

On pages 4 and 5 of the Office Action, the Examiner rejected claims 2 and 3 under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett as applied to claim 1, and further in view of Allen. Claims 2 and 3 are dependent claims, which depend from independent claim 1. As previously discussed, it is believed that independent claim 1 is patentably distinguishable over the cited art. Therefore, it is also believed that dependent claims 2 and 3 are also patentably distinguishable over the cited art.

On page 5 of the Office Action, the Examiner rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett as applied to claim 1, and further in view of Chung. Claim 8 is a dependent claim, which depends from independent claim 1. As previously discussed, it is believed that independent claim 1 is patentably distinguishable over the cited art of record. Therefore it is also believed that dependent claim 8 is patentably distinguishable over the cited art of record.

On pages 6 and 7 of the Office Action, the Examiner rejected claims 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett as applied to claim 1, and further in view of Yamagata. Claims 6 and 7 are dependent claims, which depend from independent claim 1. As previously discussed, it is believed that independent claim 1 is patentably distinguishable over the cited art of record. Therefore it is also believed that dependent claims 6 and 7 are patentably distinguishable over the cited art of record.

On pages 7-10 of the Office Action, the Examiner rejected claims 9, 10, and 15 under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Richie, Beckett, and Yamagata. Claim 9 is an independent claim. In rejecting claim 9, the Examiner relied on Cantone as disclosure of a personal movie storage module comprising a storage device removably connected to a playback device and capable of storing at least one movie, referencing the VCR of Figure 3 and column 2, lines 20-30, 56-58, and 60-62. The Examiner indicated that Cantone fails to specifically disclose that the playback device is capable of displaying the movie and that the storage module includes an atomic resolution memory device and a communication interface for communicating to and from the memory components of the storage module. The Examiner indicated that Richie discloses the use of a portable video playback device which will display video from a storage module for the

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benefits of allowing video playback while at various locations, citing Figure 1 and column 1, lines 50-52, column 2, lines 7-14, 20-28, and 37-43. The Examiner further indicated that Beckett discloses an information storage device consisting of an atomic resolution storage component, referencing page 1, paragraphs 5-6. Furthermore, the Examiner indicated that Yamagata discloses a storage device (100) containing a communication interface (6) and being coupled to a power supply (power supply circuit 150 and battery 130) for the purpose of transferring data between an external unit and the device (column 2, lines 66-68).

As amended, the portable digital movie storage module of independent claim 9 includes a portable digital ultra-high capacity storage device removably connectable to a portable digital playback device capable of displaying a digital movie. The cited prior art, taken individually or in combination, does not disclose displaying a digital movie on a portable digital playback device.

Cantone merely discloses transferring analog data from a VCR-sized cassette to a conventional VCR machine. Cantone is silent regarding a portable digital playback device capable of displaying a digital movie. Richie merely discloses a portable analog videocassette player which includes reel structure 26 and audio/video pick-up heads 58 and 60. Richie is silent regarding a portable digital playback device capable of displaying a digital movie. Additionally, both Beckett and Yamagata are silent regarding a portable digital playback device capable of displaying a digital movie..

It is Applicant's belief that independent claim 9, and dependent claims 10 and 15 are patentably distinguishable over the cited art of record.

On pages 11 and 12 of the Office Action, the Examiner rejected claims 11-14 under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, Beckett, and Yamagata as applied to claim 9, and further in view of Gibson. Claims 11-14 are dependent claims that depend from independent claim 9. As previously discussed, it is believed that independent claim 9 is patentably distinguishable over the cited art. Therefore, it is believed that claims dependent claims 11-14 are also patentably distinguishable over the cited art.

On pages 13-16 of the Office Action, the Examiner rejected claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over Cantone, in view of Richie, Beckett, Yamagata, and Allen. Claim 16 is an independent claim. The Examiner indicated that Cantone discloses a portable movie storage system for storing at least one movie and a movie

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playback device removably connectable to the storage memory device, referencing Figure 3 and column 2, lines 20-30 and 60-62. The Examiner indicated that Richie, and an analogous art, disclosed the use of a portable video playback device which will display video from a storage module for the benefits of allowing video playback while at various locations, citing Figure 1 and column 2, lines 7-14, 20-28, 37-43, and 50-62. The Examiner further indicated that Beckett, in analogous art, discloses an information storage device consisting of an atomic resolution storage component, referencing page 1, paragraphs 5 and 6. Furthermore, the Examiner indicated that Yamagata, and analogous art, discloses a storage device (100) containing a communications interface (6) and being coupled to a power supply (power supply circuit 150 and battery 130) for the purpose of transferring data between an external unit and the device, referencing column 2, lines 66-68. Finally, the Examiner indicated that Allen, in analogous art, discloses a system allowing purchasable access to electronically stored movies, a centralized movie database for downloads to multiple points of purchase, and a point of purchase center for selectable transferring of a copy of the selected movie from the database to the movie storage module memory component, citing column 2, lines 22-24, 44-48, and column 3, lines 34-40.

With this Amendment, independent claim 16 has been amended such that the portable digital movie handling system includes a portable digital movie storage module, a purchasing system permitting purchasable access to digital movies, and a portable digital movie playback device for displaying the digital movie from the storage memory device of the portable digital movie storage module.

Cantone, Richie, Beckett, Yamagata, and Allen are all silent regarding a portable digital movie handling system which includes a portable digital movie playback device for displaying a digital movie.

It is Applicant's belief that independent claim 16, and dependent claims 17 and 18, are patentably distinguishable over the cited art of record.

On pages 16 and 17 of the Office Action, the Examiner rejected claims 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over Cantone, Richie, and Beckett as applied to claim 1, and further in view of Russo. Claims 19 and 20 are dependent claims, which depend from independent claim 1. As previously discussed, it is believed that independent claim 1 is patentably distinguishable over the prior art of record. Therefore, it is also

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believed that dependent claims 19 and 20 are also patentably distinguishable over the cited art. In addition, it is believed that Russo does not disclose storing instructions into the portable movie storage module to limit viewing the movie to a finite number of viewings or a finite period of time, as claimed in dependent claims 19 and 20, respectively. The Examiner cited column 4, lines 10-29 and column 11, lines 5-16 of Russo as disclosure of storing instructions and deleting the movie as claimed. However, Russo does not teach, suggest, or disclose storing instructions into the portable digital movie storage module to limit viewing the movie to a finite number of viewings or a finite period of time. Russo merely discloses storing selected programs, as disclosed at column 4, lines 10-29 and automatically erasing the selected program during or immediately subsequent to retrieval of the selected program, to free up space on the high-capacity medium, as referenced at column 11, lines 11-16. There is no disclosure as to limiting viewing to a finite number of viewings or a finite period of time and deleting the movie after a finite number of viewings or a finite period of time. Thus, it is believed that for the above-mentioned reasons, dependent claims 19 and 20 are patentably distinguishable over the cited art of record.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Philip Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332 or Michael R. Binzak at Telephone No. (612) 573-0427, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to Examiner Shelchada, Group Art Unit 2614, at Fax No. (703) 872-9306 on this 11th day of March, 2005.

By Michael R. Binzak
Name: Michael R. Binzak